



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,046	03/17/2004	Steve B. Owens	11000060-0047	4606

7590 12/11/2008
IP Department
Sonnenschein Nath & Rosenthal LLP
P.O. Box 061080
Wacker Drive Station
Chicago, IL 60606

EXAMINER

STRONCZER, RYAN S

ART UNIT	PAPER NUMBER
----------	--------------

2425

MAIL DATE	DELIVERY MODE
-----------	---------------

12/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/803,046	Applicant(s) OWENS ET AL.	
	Examiner Ryan Stronczer	Art Unit 2425	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03 September 2008 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1, 9, 14, 15, 19, and 20 have been considered but are moot in view of the new ground(s) of rejection.

With respect to Applicant's argument that amended claim 12 does not constitute a new embodiment, as alleged in the previous Office Action, Examiner respectfully disagrees, as explained below. Furthermore, Applicant alleges that support for the amended limitations can be found at paragraph 0069 of the instant application; however, the cited passage of the specification states that "each of [the plurality of controllers] controls a plurality of decoders," but does not explicitly teach or imply that all of the controllers controls the same group of decoders, as is presently recited by claim 12.

Election/Restrictions

As stated in the previous Office Action, amended claim 12 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: all originally presented claims, including original claim 12, were directed to an embodiment in which a single controller controls a plurality of decoders. In contrast, amended claim 12 cancels all the original claim language (except for the “The system of claim 1”) and introduces an embodiment of claim 1 further comprising “a plurality of controllers, each of the plurality of controllers is configured to control the plurality of decoders,” which was not recited or suggested by the original claim language and would represent an additional search burden on the Examiner.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 12 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-7, 11-16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norcott et al. and further in view of Ahmad et al. and Fish et al.

The rejection of claim 1, as stated in the previous Office Action is incorporated herein. As to amended claim 1, Norcott, as applied in the previous Office Action, teaches a system for providing multiple users in a facility access to multimedia content stored remotely from the location in said the content is being accessed. Fig. 1 of Norcott teaches a “content and administration server” including storage for content media, as well as a means for a distributing the stored content to one or more users through a communications channel. As to amended limitation that the instructions are received “through a data network of the facility,” Fig. 1 of Fig. 1 of Norcott teaches multiple computer terminals (Fig. 1/element **64**) which can simultaneously access content from the content database (col. 5/50-56) through LAN **42**. The LAN taught by Norcott is equivalent to the recited data network.

As to the recited “plurality of decoders,” Fig. 1 of Norcott teaches multiple computer terminals (Fig. 1/element **64**) which can simultaneously access content from the content database (col. 5/50-56) and suggests that content can be delivered to multiple media players (col. 1/46-48), but does not explicitly teach a method for incorporating additional decoders or modulators as a method to disseminate content to multiple media players. Fig. 2 of Ahmad teaches an analogous system in which a controller and a user interface (communications module **216**) control multiple decoders (ICM **206**) connected to television monitors. As Norcott suggests the possibility of

Art Unit: 2425

delivering content to multiple media players, it would have been obvious to one skilled in the art at the time of the invention to modify the system of Norcott with the multiple decoders taught by Ahmad to distribute content to multiple users.

As to the amended limitation of “a first modulator for receiving a plurality of analog signals including said first analog signal and modulating said plurality of analog signals into a modulated signal for transmission purposes over the cable network,” Fig. 1 of Norcott teaches a TV Modulator **50** which receives video content from A/V I/O **48**. Norcott teaches that AV I/O 48 contains *“multi-channel PCI computer digital video decoder cards...to provide analog audio and video to [RF] television and video monitors, such as represented by 60”* (col. 4/21-25). The modulator taught by Norcott is equivalent to the recited first modulator.

As to the amended limitation “...wherein content from the plurality of files is played independently by a plurality of media players on at least one separate channel from the modulated signal,” the plurality of computer terminals 64 taught by Fig. 1 of Norcott are capable of accessing the files on the database via LAN 42 which is equivalent to the recited “at least one separate channel from the modulated signal.”

Claim 2 recites the functionality “wherein each of said plurality of decoders communicates with said server through a separate communications channel.” This functionality is inherent in Internet/LAN communications in which multiple devices are accessing the same data source.

Claim 3 is rejected for the same reason as set forth in the previous Office Action.

Claim 5 is rejected for the same reason as set forth in the previous Office Action.

Claim 6 recites the system of claim 1, further comprising the limitation wherein, “said user interface includes a PC networked with said controller through the data network for receiving instructions.” Fig. 1 of Norcott teaches a user terminal connected to the server interface via a LAN. *“Therefore, the user terminal **64** may be a computer **68** which can both receive and transmit data or commands to the server **12** over a single communications channel **14**”* (col. 2, lines 53-55).

Claim 7 recites the system of claim 1 wherein, “said first decoder further comprises a DVD decoder.” As applied to claim 7 in the previous Office Action, Norcott teaches a *“multi-channel PCI computer digital video decoder card (not shown)”* (Col 4, Lines 21-22).

Claim 8 is rejected for the same reason as set forth in the previous Office Action. As to the limitation that “said user interface and said instructions are displayed to a media player in a present location of a user,” Col. 5-6 of Norcott teach multiple interfaces through which a user can interact with the system and describe a series of prompts or menus presented to the user in the course of such interaction.

As to amended claim 9, Norcott teaches that *“...in the preferred embodiment, a plurality of TV modulators **50** are provided, each TV modulator **50** serving a separate simultaneous end user's television set **60**,”* (col. 4/15-18) which is equivalent to the recited “wherein each of the plurality, of analog signals are modulated into a dedicated channel associated with each of the plurality, of decoders.”

As to claim 10, Norcott teaches that an existing CATV network, telephone system or LAN can be used to interface with the “Content and Administration Server” of Fig. 1.

Art Unit: 2425

*“Thus, communications channel **14** may be a coaxial cable...a dedicated Internet line...a telephone line capable of transmitting modem or voice signals, a wireless, cellular, or other RF channel, or any other communications channel...”* (Col 4, Lines 32-37). The IR blaster taught by the combination of Fish and Norcott, as analyzed w/r/t claim 1, would allow the system controller to control subordinate devices through IR channels. That said IR signals are “pre-programmed to be utilized by said plurality of decoders” is inherent in that any device would have to be pre-configured to respond to IR commands as desired.

As to claim 11, col. 4 of Norcott (cited above) teaches that a coaxial cable may be used to transmit content to the user terminals. Demodulating a signal is inherent in receiving and displaying a modulated signal.

As to claim 13, the rejection of claim 1 is incorporated herein. As analyzed above, the combination of Norcott and Ahmad teaches the use of a plurality decoders to simultaneously provide content to a plurality of output devices.

As to claims 14 and 19, Fig. 7a and 7b of Ahmad teach that audio/video module **214** contains a plurality of modulators, the output of which are sent to a combiner and combined into one modulated signal which is then distributed to the plurality of decoders **206**.

As to claim 15, the limitation that the equipment, “control one or more decoding devices through infrared signals,” is taught by the combination of Fish and Norcott, as analyzed w/r/t claims 1 and 10. The recited “one or more decoding devices” are taught by col. 4, lines 14-17 of Norcott as cited above. As to the recited “cable network

Art Unit: 2425

functioning separately from a data network,” Norcott teaches, *“In the case where a television 60 or television receiver/demodulator...are employed...the broadcast to the television 60 or television receiver/demodulator ...are closed circuit or radio frequency...”* (col. 5, lines 42-47).

As to claim 16, it is inherent that the Norcott system would stream only files requested by the user.

Claim 18 is rejected for the same reasons as set forth in the previous Office Action.

As to amended claim 20, the rejections of claims 1 and 14 are incorporated herein. As to the amended limitation the controller “[receives] instructions selecting media data through a data network of the facility,” Fig. 1 of Fig. 1 of Norcott teaches multiple computer terminals (Fig. 1/element 64) which can simultaneously access content from the content database (col. 5/50-56) through LAN 42. The LAN taught by Norcott is equivalent to the recited data network. As to the amended limitation of “coordinating modulation of one or more data streams from the plurality of decoding devices into a combined data stream, wherein each of the data streams may be displayed by the plurality of media players on a dedicated channel broadcast through a cable network of the facility independent from the facilities computer network and using said administrating system to cause any data stream to by pass the facilities computer network,” Ahmad, as applied to claim 14, teaches the recited combining. The trunk taught by Fig. 7b of Ahmad is equivalent to the recited cable network independent of the computer network.

Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norcott et al. in view of Fish et al. as applied to claim 1 above, and further in view of Schultz et al. (Pub. No.: US 2004/0194148).

As to the limitations in claims 4 and 17 that the system provides a series of prompts on the a media player as the user is interacting with the controller via a telephone, Fig. 1 of Norcott teaches a telephone as a means for communicating with the Input/Output module: “[t]he telephony I/O **46** connects to a signaling system...In utilizing a telephone **56**, a standard PCI computer accessory card (not shown)...[and] provides voice prompts and interprets touchtone responses from the user via the telephone **56**” (Col. 4, Lines 5-10); however, Norcott does not explicitly teach that the system “synchronously” displays prompts on a display, as recited. Schultz teaches a system for telephone controlled entertainment in which the user can issue commands to a set top box via the user's cellular phone. Schultz teaches, “[t]he system provides feedback to the user as the command is being verified. The feedback can be provided visually on the output, audibly on the output...or using a combination of these techniques” [0041]. It would have been obvious to one of ordinary skill in the art at the time of the investment to incorporate the command-verification taught by Schultz into the system taught by Norcott to allow the user to visually verify their selections while using the telephone interface taught by Norcott.

Contact

Art Unit: 2425

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Stronczer whose telephone number is (571) 270-3756. The examiner can normally be reached on 7:30 AM - 5:00 PM (EDT), Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian T. Pendleton can be reached on (571) 272-7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R.S./
Examiner, Art Unit 2425

/Brian T. Pendleton/
Supervisory Patent Examiner, Art Unit 2425